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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,727	03/19/2004	Peter Lappe	RUH-339	8264
47888	7590	01/25/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			CARR, DEBORAH D	
		ART UNIT	PAPER NUMBER	
		1621		

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/804,727	LAPPE ET AL.	
	Examiner Deborah D. Carr	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 December 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3 and 5 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3 and 5 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 7 December 2005 regarding claims 1, 3 & 5 have been fully considered but they are not persuasive.

### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3 & 5 rejected under 35 U.S.C. 102 (a) as being clearly anticipated by Chapaton et al. (US'680).

Applicant argues that US'680 does not anticipate the instant invention of dicarboxylic acid of 7, 8, or 10 carbons but teaches esters of malonic and succinic acid. Nor does the compounds taught in US'680 have the advantageous properties shown in the declaration supplied.

While US'680 exemplify esters of malonic and succinic acid now excluded from the claimed invention, compounds of a broader range are taught. As shown in col.3, lines 5-20, R<sub>3</sub> represents straight or branched alkyl groups with 1 to 8 carbons, therefore still reading on the invention as presently amended. In fact the esters that are taught in US'680 are disclosed as examples 1 & 2 on page 8 of the specification.

The two compounds listed on page 2 of the declaration read on the compounds taught in US'680.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 3 & 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Bannock (US'458).

US'458 teach 2-hydroxymethylnorbornane based carboxylic acid esters, a method of preparing said esters and the use of them in lubricants. The compounds differ from the instant compounds by containing a methyl substituent on the norbornane ring.

Applicants' argues that US'458 do not render obvious the applicants' invention because US'456 are directed to diesters of methyl substituted norbornane. In addition, the method of preparing norbornane would not produce the instant compounds with their properties of low viscosity or Pour Point.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pour point & low viscosity) are not recited in the rejected claim(s). The use of a known member of a class of materials in a process is not patentable if other members of the class were known

to be useful for that purpose. Once the general reaction has been shown to be old, burden is on the applicant to present reason or authority for believing that a group on the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or operability of the process. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to Applicant's remark that in 40 years since Brannock, there has been no modification of 2-methyl-norbornane is not correct, Chapaton teaches an unsubstituted norbornane. Which supports that substitution of hydrogen for methyl or visa versa is considered to be *prima facia* obvious.

The declaration under 37 CFR 1.132 filed 22 June 2005 is insufficient to overcome the rejection of claims 1,3 & 5 based on 35 USC§103 as set forth in the last Office action and as presently applied because: The properties that are disclosed in the declaration are not supported in the specification. There is no teaching or suggestion that the instant compounds exhibit low viscosity or a better pour point. Nor is there any guidance in the specification to extrapolate if the parameters argued in this declaration are considered novel or unobvious. Attorney's arguments of unexpected results cannot take the place of evidence in the record.

In fact the pour point disclosed in Table 1 for the instant compounds is higher than that for the compounds taught in US'456. This lower pour point for US'456 compound would indicate that they exhibit improved behavior in low temperature applications.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DEBORAH D. CARR  
PRIMARY EXAMINER

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